IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Gerbrand Deetman : Examiner: Ogden, Jr., Necholus

Serial No.: 09/801,883 : Group Art Unit: 1751

: Group Art Omt. 173

Filed: March 8, 2001 : Attorney Docket No.: 713629.354

:

For: STABILIZED PHOSPHATE

ESTER-BASED FUNCTIONAL

FLUID COMPOSITIONS : Customer No.: 27128

:

: Confirmation No.: 7184

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Responsive to the Restriction Requirement, dated November 3, 2006, Applicant hereby provisionally elects for prosecution at this time the species designated by the Examiner as relating to a hindered phenol and identifies claims 107-130 as encompassing such species. However, this election is made with traverse without prejudice to the elected species and without prejudice to the non-elected species. This traverse of the Restriction Requirement is not on grounds of any issue of patentability, but on grounds that the Examiner improperly construed the claims.

Reconsideration and withdrawal of the requirement for restriction is respectfully requested. Applicants contend that the Examiner has not properly considered and misinterpreted the Markush Group in claims 107 (d) and 115 (d), both of which contain a <u>combination</u> of at least one hindered phenol <u>and</u> at least one amine compound. Properly construed, this Markush

Application of: Gerbrand Deetman

Serial No.: 09/801,883

Response to Restriction Requirement

Group does not include an amine compound by itself, i.e. not in combination with a hindered

phenol compound. The amine compound is only claimed in combination with a hindered phenol.

There are no pending claims directed to only an amine compound or only a hindered phenol.

Independent claims 111 and 115 recites a novel combination of additives comprising both an

amine, i.e. see 111(e) and 115(e), and a hindered phenol, i.e. see 111(f) and 115(f). Thus,

properly construed the claims do not recite a species containing only an amine compound.

Consequently, it is respectfully submitted that the Restriction Requirement is not proper and

should be withdrawn.

The Examiner's position set forth in the Action that, should Applicant's traversal of this

requirement for election be on the ground that different embodiments of the same invention are

presented, this could be considered an admission in a subsequent prior art rejection on the ground

that one species is obvious in view of the other, is believed improper and contrary to the law. It

is believed clear that Applicant's teaching of equivalency in Applicant's own specification is not

available to the Examiner as an admission in a rejection under 35 U.S.C. 103. The equivalence

must be disclosed in the prior art. Any disclosure of equivalence in Applicant's specification

cannot be used by the Examiner to support his rejection. See In re Ruff et al., 256 Fed. 2d. 590,

118 USPO 340. Therefore, this portion of the Action would represent an improper use of

Applicant's disclosure and Applicant's traversal of this election requirement cannot be used

2

against Applicant in future prosecution of this application.

Reconsideration and withdrawal of the requirement for restriction are respectfully

requested. Because Applicants may wish to pursue claims of the non-elected species at a later

STLD01-1273225-2

Application of: Gerbrand Deetman

Serial No.: 09/801,883

Response to Restriction Requirement

date by Divisional Application, if necessary, it is requested that non-elected claims, pursuant to

37 CFR 1.142, be permitted to remain in the application, but withdrawn from examination.

This response does not present any new matter. Accordingly, as all requirements of the

Action have been complied with, an action on the merits and a Notice of Allowance are hereby

respectfully requested.

If any issue regarding this election or the allowability of any of the pending claims in the

present application could be readily resolved, or if other action could be taken to further advance

this application such as an Examiner's amendment, or if the Examiner should have any questions

regarding the present election, it is respectfully requested that the Examiner please telephone

Applicant's undersigned attorney in this regard.

Respectfully submitted,

Date: November 28, 2006

Mark F. Wachter Reg. No. 27,243

Blackwell Sanders Peper Martin LLP

720 Olive Street, Suite 2400

St. Louis, MO 63101

314-345-6000

ATTORNEYS FOR APPLICANT

3